

REMARKS

This is a full and timely response to the non-final Official Action mailed October 28, 2010 (the "Office Action" or "Action"). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Under the imposition of a previous provisional restriction requirement, claims 33-42 have been withdrawn from consideration. Of these, claim 34 had been cancelled previously without prejudice or disclaimer. Applicant will be entitled to rejoinder of claims 33 and 35-42 upon allowance of independent claims 1, 20 and 28. MPEP § 821.04.

By the preceding amendment, claims 28, 29, and 31 have been amended. Additionally, original claim 32 has been cancelled without prejudice or disclaimer. Further, claims 21 and 30 were cancelled previously without prejudice or disclaimer. Thus, claims 1-20, 22-29, and 31 are currently pending for further action.

Allowed Subject Matter:

In the outstanding Office Action, the Examiner failed to address the patentability of independent claim 28 based on any cited references. The Office Action had, however, rejected claim 28 under 35 U.S.C. §112, first paragraph. Applicant believes that claim 28 is now allowable because 1) no references have been cited to substantively reject the subject matter of claim 28, and 2) the references cited in the Office Action fail to teach, anticipate or render obvious claim 28. Because the Examiner has failed to apply any cited references in the rejection of claim 28, a *prima facie* case of anticipation has not been demonstrated.

Applicant respectfully requests, therefore, that claim 28 and its dependent claims be deemed as allowed.

35 U.S.C. §112, 6th Paragraph:

In the outstanding Office Action, the Examiner had indicated that “claims 31 & 32 . . . appears to not meet the requirements set forth in MPEP §2181, because the third requirement for invoking 35 USC 112, 6th paragraph has not been met.” (Action, p. 4). In response, Applicant has amended claim 31 to address the issues raised by the Examiner. Additionally, claim 32 has been deleted without prejudice or disclaimer. In light of these amendments, it is believed that claim 31 is meets the requirements of 35 U.S.C. 112, 6th paragraph and notice to that effect is respectfully requested.

Objection to Specification

In the outstanding Office Action, the Examiner objected to the specification because of an informality. Specifically, the Office Action asserts that “[t]he written description only implicitly or inherently sets forth the corresponding structure, material, or acts that perform the claimed functions” of “means for detecting ... ; means for receiving information ... ; and means for dispensing ... ‘ and ‘means for capturing an image of the eye’” found in claims 28 and 29. (Action, p. 4).

Applicant, however, disagrees. For example, the “means for detecting” found in claim 28 may be, for example, an “image pick-up device 152 positioned in front of an eye, . . . [and] a processor 156.” (Applicant’s Specification, paras. [60]-[61]). Additionally, the “means for dispensing” may be, for example, “a jet dispenser, such as a thermal jet dispenser or a piezoelectric jet dispenser.” (*Id.* at para. [22]).

Additionally, claims 28 and 29 have been amended to address the additional issues raised by the Office Action. In light of the above amendments and arguments, the objection to the specification should be reconsidered and withdrawn.

Rejection under §112, first paragraph:

In the recent Office Action, claims 28, 29, 31, and 32 were rejected under 35 U.S.C. § 112, first paragraph. These claims have been carefully reviewed in light of the Examiner's comments.

While Applicant does not necessarily agree that any of these claims failed to comply with the written description requirement, the indicated claims have been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 112, first paragraph. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Rejections under §112, second paragraph:

In the recent Office Action, claims 31 and 32 were rejected under 35 U.S.C. § 112, second paragraph. These claims have been carefully reviewed in light of the Examiner's comments.

While Applicant does not necessarily agree that any of these claims were indefinite as filed, the indicated claims have been amended herein to address the issues raised by the Examiner under 35 U.S.C. § 112, second paragraph. Following this amendment, all the remaining claims are believed to be in compliance with 35 U.S.C. § 112 and notice to that effect is respectfully requested.

Rejections under §102(a) or (e):

1. In the recent Office Action, claims 1, 4-6, 8, 16, 20, and 23 were rejected under 35 U.S.C. § 102(a) and 102(e) as being anticipated by U.S. Patent No. 6,945,650 to Beverly (hereinafter Beverly). For at least the following reasons, this rejection should be reconsidered and withdrawn.

Claim 1:

Claim 1 recites:

An ophthalmic apparatus comprising:
an eye-positioning device comprising:
an electronic feedback device configured to provide information to a subject who is moving an eye from a current position to a desired position relative to the eye positioning device; and
an applicator for dispensing the fluid into the eye conditionally upon positioning of the eye in the desired position.
(Emphasis added).

In contrast, Beverly does not teach or suggest “[a]n ophthalmic apparatus comprising: . . . an electronic feedback device configured to provide information to a subject who is moving an eye from a current position to a desired position relative to the eye positioning device.” (Claim 1). The recent Office Action asserts that “[t]he language ‘configured to provide information to a subject who is moving an eye from a current position to a desired position relative to the eye positioning device’ is functional language.” (Action, p. 7). The Office Action further asserts that Beverly “is capable of performing the intended use” because “Beverly provides positioning information to the operator, who then is capable and free to instruct the subject to move his/her eyes to the desired position.” (*Id.*). This is incorrect.

Careful reading of Beverly shows that the operator implementing the apparatus taught in Beverly cannot instruct the subject to move his/her eyes. Indeed, Beverly teaches that the

ophthalmic instrument is to be aligned “while simultaneously presenting *a fixation target to the patient* along the optical axis.” (Beverly, col. 2, ll. 52-58) (emphasis added). Numerous other references to the fixation point and the operator moving the apparatus in Beverly can be found at, for example, the abstract; col. 4, ll. 37-48; col. 4, ll. 53-65; col. 3, ll. 17-29.

Indeed, nowhere within Beverly is it taught or suggested that the operator instructs the patient to move his or her eye at all and instead teaches that the patient must fixate his or her eye on a fixation point. The Office Action therefore mischaracterizes Beverly in asserting that the operator “is capable and free to instruct the subject to move his/her eyes to the desired position.” (Action, p. 7). This mischaracterization of Beverly results in a change in the intended purpose of the prior art because the patient is to fix his or her view on a fixation point and is therefore not to move his eye.

Beverly also teaches away from “an electronic feedback device configured to provide information to a subject.” (Claim 1). With the apparatus in Beverly no information is to be provided to the subject but is instead provided only to the operator because the patient is to be engaged in fixing his or her view on the fixation point.

In contrast, the subject matter of claim 1 includes “[a]n ophthalmic apparatus comprising: an electronic feedback device configured to provide information to a subject who is moving an eye from a current position to a desired position relative to the eye positioning device.” (Claim 1). This is clearly not taught or suggested in Beverly.

Respectfully, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown *in as complete detail as contained in the ... claim.*” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in

order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)).

In the present case, Beverly clearly does not disclose the claimed invention with each and every claimed element in the same amount of detail or as arranged in the claim. Consequently, because Beverly clearly fails to satisfy the requirements for anticipating claim 1, the rejection of claim 1 and its dependent claims should be reconsidered and withdrawn.

Claim 20

Claim 20 recites:

An ophthalmic apparatus, comprising:
a dispensing apparatus for dispensing fluid into an eye of a subject;
an eye-position detector for detecting the current position of the eye relative to the dispensing apparatus; and
a feedback device for receiving information from the eye-position detector corresponding to the position of the eye,
wherein the feedback device provides feedback information to the subject that assists the subject in moving the eye from the current position to a predetermined position relative to the dispensing apparatus for administering the fluid to the eye.

(Emphasis added).

In contrast, Beverly does not teach or suggest “[a]n ophthalmic apparatus comprising: . . . a feedback device . . . wherein the feedback device provides feedback information to the subject that assists the subject in moving the eye from the current position to a predetermined position relative to the dispensing apparatus for administering the fluid to the eye.” (Claim 20). Much like the arguments made by the Office Action in rejecting claim 20, the Office Action again states that Beverly “is capable of performing the recited function in its normal operation” because “Beverly provides positioning information to the operator, who then is

capable and free to instruct the subject to move his/her eyes to the desired position.” (*Id.*).

This is incorrect.

Beverly teaches that the ophthalmic instrument is to be aligned “while simultaneously presenting *a fixation target to the patient* along the optical axis.” (Beverly, col. 2, ll. 52-58) (emphasis added). The Office Action therefore mischaracterizes Beverly. This mischaracterization of Beverly results in a change in the intended purpose of the prior art because the patient is to fix his or her view on a fixation point and is therefore not to move his eye.

Beverly also teaches away from “feedback device [which] provides feedback information to the subject.” (Claim 20). With the apparatus in Beverly no information is to be provided to the subject but is instead provided only to the operator because the patient is to be engaged in fixing his or her view on the fixation point.

In contrast, the subject matter of claim 20 includes “[a]n ophthalmic apparatus comprising: . . . a feedback device . . . wherein the feedback device provides feedback information to the subject that assists the subject in moving the eye from the current position to a predetermined position relative to the dispensing apparatus for administering the fluid to the eye.” (Claim 20). This is clearly not taught or suggested in Beverly.

Respectfully, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown *in as complete detail as contained in the ... claim.*” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in

the claim.”” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)).

In the present case, Beverly clearly does not disclose the claimed invention with each and every claimed element in the same amount of detail or as arranged in the claim. Consequently, because Beverly clearly fails to satisfy the requirements for anticipating claim 20, the rejection of claim 20 and its dependent claims should be reconsidered and withdrawn.

Rejections under 103(a):

1. In the recent Office Action, claims 3, 18 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,945,650 to Beverly (hereinafter Beverly) in view of U.S. Patent No. 6,270,467 to Yee (hereinafter Yee). The rejection of claims 3, 18, and 19 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.
2. In the recent Office Action, claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,945,650 to Beverly (hereinafter Beverly) in view of U.S. Patent No. 6,299, 305 to Miwa (hereinafter Miwa). The rejection of claim 7 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.
3. In the recent Office Action, claims 9, 10, 14, 15, and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,945,650 to Beverly (hereinafter Beverly) in view of U.S. Patent No. 5,171,306 to Vo (hereinafter Vo). The rejection of

claims 9, 10, 14, 15, and 22 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claims 1 and 20.

4. In the recent Office Action, claims 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,945,650 to Beverly (hereinafter Beverly) in view of U.S. Patent No. 5,171,306 to Vo (hereinafter Vo) in further view of U.S. Patent No. 5,368,582 to Bertera (hereinafter Bertera). The rejection of claims 11-13 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.

5. In the recent Office Action, claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,945,650 to Beverly (hereinafter Beverly) in view of U.S. Patent No. 5,368,582 to Bertera (hereinafter Bertera). The rejection of claim 17 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 1.

6. In the recent Office Action, claims 24 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,945,650 to Beverly (hereinafter Beverly) in view of U.S. Patent No. 6,159,186 to Wickham et al. (hereinafter Wickham). The rejection of claims 24 and 25 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 20.

7. In the recent Office Action, claims 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,945,650 to Beverly (hereinafter Beverly) in view

of U.S. Patent No. 6,159,186 to Wickham et al. (hereinafter Wickham) in further view of U.S. Patent No. 5,171,306 to Vo (hereinafter Vo). The rejection of claims 26 and 27 should be reconsidered and withdrawn for at least the same reasons given above in favor of the patentability of independent claim 20.

Conclusion:

In view of the preceding arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue, or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: January 11, 2011

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